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IN THE

Supreme Court of the United States

OCTOBER TERM, 1966.

No. 552

ZEGERS, INC.,

Petitioner,

vs.

EDWARD A. ZEGERS,

Respondent.

BRIEF IN OPPOSITION TO PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SEVENTH CIRCUIT.

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Respondent, Edward A. Zegers, plaintiff in the patent infringement suit in the District Court, opposes the petition for a writ of certiorari to review that portion of the judgment of the United States Court of Appeals for the Seventh Circuit entered in the above entitled case on July 11, 1966, affirming the judgment of the District Court holding claims 5 and 6 of Zegers Patent No. 3,058,176 as valid and infringed.

JURISDICTION.

None of the grounds on which petitioner attempts to invoke jurisdiction of this Court is sufficient because:

(1) This case presents nothing more than the usual patent infringement case.

(2) There is no conflict between the decision of the Court of Appeals for the Seventh Circuit in this case and the decisions of this Court cited by the petitioner.

QUESTIONS PRESENTED.

Petitioner incorrectly states that the holding of the Court of Appeals that claims 5 and 6 of the patent in suit are valid and infringed is in conflict with the decision of this Court in *Graham et al.* v. *John Deere Co.* and *Calmar, Inc.* v. *Cook Chemical Co.*, 383 U. S. 1. It is not.

Petitioner incorrectly states that the facts in this case compel a holding that the subject matter of claims 5 and 6 would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertained (35 U. S. C. 103). The opinions of both the District Court and the Court of Appeals show that both courts carefully considered the facts in this case and the standard of patentability as provided by 35 U. S. C. 103, and properly decided this question contrary to this contention of the petitioner.

The petitioner incorrectly states that the invalidity of claims 5 and 6 is so clear that this Court should grant the writ and summarily reverse the judgment holding these claims valid and infringed. There is no basis in fact or in law for this statement of petitioner.

STATEMENT OF THE CASE.

Petitioner's statement of the case is incomplete in that it fails to point out that:

(1) The petitioner admitted novelty and utility of claims 5 and 6.

(2) The petitioner admitted infringement of claims 5 and 6, if those claims were valid.

(3) The petitioner had previously patented (Wm. Zegers Patent N. 2,869,184, EA-8) and sold a flat clip for mounting combination weatherstrip and sash balance units in window frames. This clip had to be nailed or stapled to the frame. When the petitioner adopted its admittedly infringing press-in clip, it took over 80 to 85% of the petitioner's total clip market substantially immediately (A-71).

(4) Dado grooves are provided in most window frames. When the respondent conceived and reduced to practice his patented press-in clip (which could be mounted in a dado groove) many thousands of the flat nail-on clips of the petitioner had previously been nailed across such dado grooves by workmen skilled in the art without their appreciating that a press-in clip could be provided. The petitioner did not come on the market with its admittedly infringing press-in clip until three years after respondent had conceived and marketed his press-in clip; and this was after the petitioner had admittedly unsuccessfully attempted to provide a press-in clip. With respect to these matters the Court of Appeals stated (PA-9a*):

> "The plaintiff conceived his press-in clip and reduced it to practice early in 1959. The defendant did not place its version of the press-in feature on the market until three years later, during which time it admittedly experimented with many variations of its earlier flat nail-on clip, including some which incorporated barbed recessed members. Thus, even if the record does not disclose any substantial long-felt need for the press-in clip, the evidence does show that the defendant struggled with the solution to a problem already solved by the plaintiff.

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* The pages of the opinion of the District Court and Court of Appeals appearing at the back of the Petition are referred to as (PA- .....).

"As we have stated, the novelty and utility of the press-in feature were admitted. The plaintiff's clip affords a faster and easier means for mounting both flangeless and flanged weatherstrip in window frames than anything previously known in the art. With it, weatherstrip units may be mounted without any tools whatsoever. A workman may either press the clip into the dado groove manually and then flexibly attach the weatherstrip unit, or he may mount the clip onto the weatherstrip unit, insert the unit into the window frame, and then press the clip into the groove. Despite the advantage thus gained by utilizing the otherwise useless dado groove, the evidence showed that for two years prior to the introduction of the press-in clip, many thousands of the defendant's flat clips were nailed directly across dado grooves during the installation of window units by workmen skilled in the art without ever appreciating the savings which could be made."

(5) The admittedly infringing clip of the petitioner embodies all of the details of construction of the plaintiff's patented clip, and merely adds some tongues thereto in the form of runners. Such tongues were shown to be useless at the trial (A. 44-48, 88-89). The petitioner obtained a patent on its admittedly infringing press-in clip (Wm. Zegers Patent No. 3,122,798, PX-15, EA-14). With respect to these matters the Court of Appeals stated as follows (PA-9a):

"Finally, when the defendant did come out with a clip embodying the press-in feature of claims 5 and 6 of the plaintiff's patent, a clip which contains strikingly similar details and little else and which admittedly infringes these claims, the defendant obtained another patent for it."[10]

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10. "United States Letters Patent No. 3,122,798, granted March 3, 1964 on an application filed April 11, 1962."

REASONS FOR NOT GRANTING THE WRIT.

1. This is an ordinary patent infringement suit with the petitioner merely asking this Court to review, de novo, the fact finding of both the District Court and the Court of Appeals. This is the only infringement suit filed on the aforementioned patent and, therefore, there is no conflict between decisions of various circuits.

2. The claimed conflict with decisions of this Court does not exist:

The petitioner suggests that the District Court, and the Court of Appeals, in holding claims 5 and 6 of the patent in suit valid, have deviated from the standard of patentability set forth by this Court in the cases of *Graham* v. *John Deere Co.* and *Calmar, Inc.* v. *Cook Chemical Co.*, 383 U. S. 1, 15 L. ed. 2d 545. This is erroneous.

With respect to the standards of patentability, this Court in the aforementioned *Graham* and *Calmar* cases stated (p. 553):

> "The Act sets out the conditions of patentability in three sections. An analysis of the structure of these three sections indicates that patentability is dependent upon three explicit conditions: novelty and utility as articulated and defined in § 101, and § 102, and nonobviousness, the new statutory formulation, as set out in § 103."

The petitioner admitted, and both the trial court and appellate court found, novelty and utility with respect to the subject matter of claims 5 and 6. Therefore, the only question with respect to patentability was that of "obviousness" under 35 U. S. C. 103.

With respect to the test of "obviousness" under the 1952 Patent Act, this Court in the aforementioned *Graham* and *Calmar* cases stated (p. 549):

> "We have concluded that the 1952 Act was intended to codify judicial precedents embracing the principle long ago announced by this Court in *Hotchkiss* v. *Greenwood*, 11 How. 248, 13 L. ed. 683 (1850), and that, while the clear language of § 103 places emphasis on an inquiry into obviousness, *the general level of innovation necessary to sustain patentability remains the same.*"*

As this Court stated in the aforementioned *Graham* and *Calmar* cases (p. 553), the test set forth in the aforementioned *Hotchkiss* case was whether

> "more ingenuity and skill . . . were required than were possessed by an ordinary mechanic acquainted with the business."

That this test was recognized and very carefully applied by the District Court with respect to the question of non-obviousness (35 U. S. C. 103) is clearly shown by the opinion of that Court (PA-24a-25a), the court stating (PA-24a):

> "Although the statutory presumption of validity applies, *I am still under the obligation of examining the prior art to determine that the conditions of 35 U. S. C. § 103 have been satisfied. Concerning obviousness, what would be obvious to one skilled in the art refers not to a specific person or to an average craftsman but to a, more or less, hypothetical craftsman skilled in the art, that is, one who had before him all of the applicable references concerning the prior art.*"

It is also clear from the opinion of the Court of Appeals (PA-1a, and 8a-10a) that the appellate court clearly recognized the proper standard to be applied, and carefully applied that standard.

3. The two prior art patents (Schuler 2,608,777, DX-10, EA-182; and Conlon 2,219,382, DX-5, EA-158) now relied

* Emphasis added through this brief unless otherwise indicated.

upon by the petitioner are not pertinent. Also, they were both carefully considered and rejected by the District Court and the Court of Appeals.

The Schuler patent is in the far-removed field of a price tag holder for use on the front edge of a store shelf. It discloses a molding having a longitudinally extending flange which may be driven into a shelf edge. The subject matter of this patent is far removed from that of claims 5 and 6 of the patent in suit, and this patent does not disclose or suggest a clip for mounting a weatherstrip unit in a window frame as defined in claims 5 and 6. As the uncontroverted testimony of respondent's expert witness shows (A. 185-187, 194-199) this patent is not as good a reference as the Beil patent No. 2,337,633 (EA-113), Goellner patent 2,275,-955 (EA-162), or Kunkel patent 2,865,061 (EA-140) considered and rejected by the Patent Office. Both the District Court (PA-24a) and the Court of Appeals (PA-10a) carefully considered and properly rejected this patent, as no more pertinent than the patents considered and rejected by the Patent Office.

The Conlon patent discloses a clip for mounting weatherstripping on the edge of an automobile door. The Conlon clip embodies a plurality of cams for progressively closing the clip as it is inserted into a complimentary shaped hole formed in the metal of an automobile door. It is not adapted to be, or intended to be, mounted in a dado groove of a window frame, as is the plaintiff's novel clip. The Conlon clip does not have the same construction as the plaintiff's press-in clip as defined in claims 5 and 6 and once the Conlon clip is installed, the weatherstrip is not readily removable therefrom. The Conlon patent does not disclose or suggest a clip for demountably mounting a weatherstrip unit in a window frame, as defined in claims 5

and 6. Both the District Court (PA-25a) and the Court of Appeals (PA-10a) carefully considered the Conlon patent and obviously were correct in their rejection thereof.

4. Petitioner suggests that respondent in a brief in earlier litigation between the same parties contended that the Conlon patent shows the patentable combination claimed in the claims in suit. This is in error. Furthermore, it is immaterial what the respondent's contentions might have been in the earlier litigation with respect to the Conlon patent, because both the District Court and the Court of Appeals in the earlier litigation, overruled the present respondent's contentions and adopted those of the present petitioner.

5. Also, with respect to the Conlon patent, petitioner fails to point out that:

a. In its brief in the aforementioned earlier litigation, the present petitioner stated (p. 33):

> "The next patent relied upon by Appellant is Conlon Patent No. 2,219,382 (App. 501), which discloses a weatherstrip unit for an automobile door. Appellant refers specifically to Figs. 5, 6, 7 and 8, of this patent and an examination of these figures will disclose wherein the Conlon device fails completely to achieve the results of the invention of the patent in suit. Fig. 5 of Conlon shows a clip. In Fig. 6, it is seen that the clip is inserted part way. *In Fig. 7., the rubber weatherstrip is being inserted by flexing the hook portions of the Conlon clip.* When the block portion of the rubber strip is secured in place in the clip, the clip is then pushed inwardly, reducing the distance between the ends of the hook portions of the clip and effectively securing the block portion of the weatherstrip in place. *Once the clip is in its fully secured position as shown in Fig. 8, there is no way the weatherstrip unit may be readily removed.*"

b. In its opinion in that earlier case, the Court of Appeals stated (299 F. 2d 769) at page 771:

> "A third patent on which defendant places great reliance is Conlon Patent No. 2,219,382, which does disclose a clip for securing weatherstripping to an automobile door, but once the Conlon clip is in place, the weatherstripping cannot be readily removed."

6. Furthermore, the petitioner fails to point out anywhere in its petition that the position now taken by the petitioner with respect to the Conlon patent is **contrary to the position stated by petitioner to the Patent Office** during the prosecution of the application which matured into the William Zegers Patent No. 3,122,798 (PX-15, EA-14) for the petitioner's *admittedly infringing* press-in clip. As shown by the file history (PX-15A, SA-22*) of that William Zegers patent, the petitioner assured the Patent Office as follows with respect to the Conlon patent (SA-35):

> "The *Conlon,* Starch, and Adams et al. Patents were all considered by the Court of Appeals in the above referred to *Zegers* v. *Zegers* case, and were found to be not pertinent to the clip device disclosed in Zegers patent 2,869,184. *It therefore necessarily follows that they are not pertinent to Applicant's clip device.*"

7. There is no basis in fact or in law for granting the petition for a writ of certiorari, or for summarily reversing the judgment of the Court of Appeals.

a. The case of *Crest Specialty* v. *Trager,* 341 U. S. 912, cited by the petitioner, is no authority for granting certiorari and summarily reversing the Court of Appeals, as requested by petitioner. The *Crest Specialty* case, of course, was decided upon its own facts. In that case, the petition for a writ of certiorari was

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* The Supplemental Appendix in the Court of Appeals is herein referred to as (SA .....).

granted and the case was put on the summary calendar. Thereafter, it was fully briefed and argued prior to the rendering of this Court's opinion.

b. Furthermore, the opinion of both the District Court (PA-15a) and the Court of Appeals (PA-1a) clearly show that both the Trial Court and the Appellate Court carefully considered the facts and carefully and properly applied the pertinent law thereto in determining that claims 5 and 6 were valid and infringed by the petitioner. Also, the facts in this case (many of which were not set forth by petitioner in its petition for certiorari, as previously pointed out herein, pp. 2-4) show that the respondent's invention, as claimed in claims 5 and 6, was anything but obvious, and that the District Court and the Court of Appeals were entirely correct in holding these claims valid.

CONCLUSION.

The decision of the Court of Appeals for the Seventh Circuit in this case is entirely correct. The grounds upon which the petitioner seeks certiorari herein are not well founded. The petition should be denied.

Respectfully submitted,

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